

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tsuyoshi TATSUKAWA et al.	Art Unit: 2832
Application No.: 10/531,522	
Confirmation No.: 9096	Examiner: M. Lian
Filing or 371(c) Date: November 21, 2007	
Title: LAMINATED CERAMIC ELECTRONIC COMPONENT AND METHOD FOR PRODUCING THE SAME	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated May 6, 2010 and the Advisory Action dated August 12, 2010, please consider Applicant's arguments and remarks concerning the rejection issued in the Office Action dated May 6, 2010 and the arguments made in the Advisory Action dated August 12, 2010.

Claims 9-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. (US 2002/0008606) in view of Ibata et al. (U.S. 6,169,470). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view of Ibata et al., and further in view of Kobayashi (US 6,229,425). Applicant respectfully traverses the rejections of Claims 9-18.

Claim 9 recites:

A laminated ceramic electronic component comprising:
a ceramic laminated member;
an inner conductor provided inside of the ceramic laminated member;
an outer electrode provided on the surface of the ceramic laminated member; and

a lead conductor connecting the inner conductor to the outer electrode;
wherein

a thickness of the lead conductor is less than a thickness of the inner conductor; and

the lead conductor is defined by a plurality of lead conductor layers that overlap and are in contact with each other. (emphasis added)

In the Office Action dated May 6, 2010, the Examiner alleged that Okuyama et al. teaches all of the features recited in Applicant's Claim 9 except for the feature of a thickness of the lead conductor is less than a thickness of the inner conductor. The Examiner further alleged that Ibata et al. teaches the feature of a thickness of the lead conductor 7 is less than a thickness of the inner conductor 5. Thus, the Examiner concluded that it would have been obvious "to use the lead conductor thickness teaching of Ibata in the laminated ceramic electronic component of Okuyama et al. to provide excellent electrical characteristics, such as reduced stray capacity, and increase productivity (col. 2, lines 2-7 [of Ibata et al.]." Applicant respectfully disagrees.

Contrary to the Examiner's allegations, Ibata et al. fails to teach or suggest anything at all about the relative thicknesses of the lead conductor 7 and the inner conductor 5. Further, Ibata et al. neither teaches nor suggests that any advantages whatsoever are or could be obtained by making the thickness of the lead conductor 7 less than the thickness of the inner conductor 5. The advantages disclosed in col. 2, lines 2-7 of Ibata et al. are specifically disclosed as being produced as a result of the conductive member 5 having a plurality of turns that are gradually different, in diameter, from each other from one end towards the other end of the conductive member 5, and are certainly **not** disclosed as being a result of the thickness of the lead conductor 7 being less than the thickness of the inner conductor 5, as alleged by the Examiner.

The Examiner is reminded that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

Thus, the Examiner has committed clear legal error and has failed to establish a *prima facie* case of obviousness in the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view of Ibata et al.

In addition, although Fig. 1 of Ibata et al. appears to show the lead conductor 7 as having a thickness that is less than the inner conductor 5, the Examiner is reminded that, when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

Ibata et al. does not disclose that any of the drawings provided therein are drawn to scale and is completely silent as to dimensions of the thicknesses of the lead conductor 7 and the inner conductor 5. Thus, Fig. 1 of Ibata et al. clearly cannot be relied upon to allegedly teach the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor" as recited in Applicant's Claim 9.

Thus, even assuming *arguendo* that there would have been a reason to combine the alleged teachings of Ibata et al. with Okuyama et al., which there clearly would not have been, the combination of Okuyama et al. and Ibata et al. would still fail to teach or suggest the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor" as recited in Applicant's Claim 9.

On the Continuation Sheet of the Advisory Action date August 12, 2010, the Examiner alleged, "Ibata et al. clearly teaches a thickness of lead conductor 7 less than a thickness of inner conductor 5 (see Fig. 1 for illustration). An objective of the coil component of Ibata et al. is to provide excellent electrical characteristics such as reduced stray capacity (col. 2, lines 2-7). To achieve such objective, at least in part, a thickness of lead conductor is made or designed

less than a thickness of inner conductor as shown throughout the figures. Therefore, the examiner has clearly established prima facie case of obviousness rejection.” Applicant respectfully disagrees.

Contrary to the Examiner’s allegations, as noted above, Ibata et al. fails to teach or suggest anything at all about the relative thicknesses of the of the lead conductor 7 and the inner conductor 5, and most certainly does not teach or suggest that the objective of providing excellent electrical characteristics, such as reduced stray capacity, is achieved in any way whatsoever, by making or designing the lead conductor to have a thickness that is less than a thickness of the inner conductor.

The Examiner’s allegation, “To achieve this objective, at least in part, a thickness of lead conductor is made or designed less than a thickness of inner conductor as shown throughout the figures,” is completely unsubstantiated by any teaching or suggestion in Ibata et al. or by any other evidence of record, and as such, constitutes a clear legal error.

In addition, the Examiner’s allegation that “Ibata et al. clearly teaches a thickness of lead conductor 7 less than a thickness of inner conductor 5,” clearly contradicts well-established law that patent drawings do not define the precise proportions of the elements and **may not** be relied on to show particular sizes if the specification is completely silent on the issue.”)

Since, as noted above, Ibata et al. does not disclose that any of the drawings provided therein are drawn to scale and is completely silent as to dimensions of the thicknesses of the lead conductor 7 and the inner conductor 5, contrary to the Examiner’s allegations, Fig. 1 of Ibata et al. clearly cannot be relied upon to allegedly teach the feature of “a thickness of the lead conductor is less than a thickness of the inner conductor” as recited in Applicant’s Claim 9. Thus, the Examiner’s allegation that Ibata et al. teaches the feature of “a thickness of the lead conductor is less than a thickness of the inner conductor” as recited in Applicant’s Claim 9 constitutes a clear factual error.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view

of Ibata et al.

The Examiner relied upon Kobayashi to allegedly cure deficiencies of Okuyama et al. and Ibata et al. However, Kobayashi fails to teach or suggest the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor" as recited in Applicant's Claim 9. Thus, Kobayashi fails to cure the deficiencies of Okuyama et al. and Ibata et al. described above.

Accordingly, Applicant respectfully submits that Okuyama et al., Ibata et al., and Kobayashi, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claim 9.

In view of the foregoing remarks, Applicant respectfully submits that Claim 9 is allowable. Claims 10-18 depend upon Claim 9, and are therefore allowable for at least the reasons that Claim 9 is allowable.

To the extent necessary, Applicant petitions the Commissioner for a One-Month Extension of Time, extending to September 6, 2010, the period for response to the Office Action dated May 6, 2010.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: September 2, 2010

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